

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
RIOU, et al.

Examiner: **PERREIRA, Melissa Jean**

Art Unit: **1618**

Application No.: **10/644,411**

Filed: **August 20, 2003**

Title: **OXINDOLES WHICH ARE INHIBITORS OF CDK-1 AND THEIR
APPLICATION IN THERAPEUTICS**

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This response is to the Examiner's Office Action, mailed June 7, 2006 (hereinafter, "Office Action").

The Commissioner is hereby authorized to charge any additional fees that may be required for this filing, or credit any overpayment to Deposit Account Number 18-1982, upon which the undersigned is authorized to draw.

Discussion and Traversal of the Restriction Requirement

The Examiner has required restriction to one of the following Groups:

- I. Claims 1-4 and 7, ...drawn to a compound...[claim 7 is drawn to a pharmaceutical composition comprising the compound];
- II. Claims 5 and 6, ...drawn to a process for preparing the compound...; and

III. Claims 8 to 12, ...drawn to the method of using the compound...(Office Action at 2).

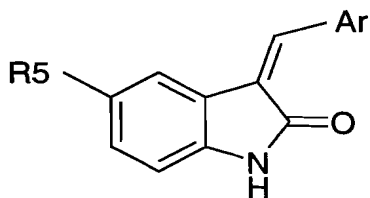
The Examiner asserts that the inventions of the Groups are distinct.

The Examiner has also required an election of a single disclosed species. The Examiner asserts that, "The species are independent or distinct because the substituent R5 being 3-pyridyl, halogen or C₁-C₄ alkyl, as well as those listed in claim 1 would render the compounds structurally and reactively different and would require an undue burden of search by the office." (Office Action at 3).

Notwithstanding the Examiner's assertions, Applicants respectfully traverse this restriction requirement.

Even though the inventions of the Examiner's Groups I to III, may be patentably distinct, as may be the species encompassed by claim 1 as listed by the Examiner, this is not the sole criterion for a proper restriction requirement. For example, there must also be a serious burden on the Examiner to search and examine all claims. (MPEP 803).

All of the compounds, processes, and methods of using of the claims derive from, or utilize compounds of formula (I), i.e.,



Thus, a search for any of the claimed inventions of the Examiner's Groups I to III, or a search for any of the distinct species listed by the Examiner, would necessarily encompass a

search for all. Accordingly, there is no serious burden on the Examiner to search all inventions of the Examiner's Groups I to III.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

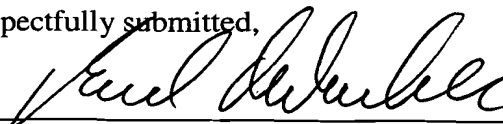
Election

In order to comply with the requirements of 37 C.F.R. § 1.143, Applicants provisionally elect, with traverse, and should the Examiner's Restriction Requirement be made final, the invention of Examiner's Group I, i.e., Claims 1 to 4 drawn to a compound, and claim 7, drawn to a pharmaceutical composition.

Applicants further elect, with traverse, the species disclosed, for example, at page 5, Example 1, and which is the first named compound of claim 4, i.e., 1,3-dihydro-3-(imidazol-4-ylmethylene)-5-(pyrid-3-yl)-2H-indolin-2-one.

In view of the present remarks, Applicants submit that the invention as defined by the claims of the present application is novel and non-obvious over the prior art, and complies with the provisions of 35 U.S.C. § 112. Therefore, allowance and passage to issue of Claims 1 to 30 are respectfully requested.

Respectfully submitted,



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Dated: June 27, 2006

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